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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/718,943      | 11/22/2000  | Thomas Gassenmeier   | H 4325              | 1228             |

7590

04/08/2003

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EXAMINER

DOUYON, LORNA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1751

21

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/718,943

Applicant(s)

GASSENMEIER ET AL.

Examiner

Lorna M. Douyon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-12, 14, 15, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-12, 14, 15, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. This action is responsive to the amendment filed on February 3, 2003.
2. The cancellation of claim 16 is acknowledged. Claims 10-12, 14-15 and 18-19 are pending.
3. The objection to the abstract of the disclosure is withdrawn in view of applicants' amendment.
4. The objection to the disclosure is withdrawn in view of applicants' amendment.
5. The objection to claim 16 is withdrawn in view of applicants' amendment.
6. The rejection of claims 10-12 and 14-16 under 35 U.S.C. 112, second paragraph is withdrawn in view of applicants' amendment.
7. The rejection of claims 10-11, 14-16 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mittelstrass et al. (DD 140987) is withdrawn in view of applicants' amendment and arguments contained therein.

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8. The rejection of claims 10, 14 and 18-19 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dorset et al. (US Patent No. 5,486,317), hereinafter "Dorset" is withdrawn in view of applicants' amendment.

9. The rejection of claims 10, 12, 14-16 and 18-19 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Riddick et al. (US Patent No. 5,573,697) is withdrawn in view of applicants' amendment.

10. Claims 10-12, 14-15 and 18-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Block et al. (WO 92/17404), hereinafter "Block" for the reasons set forth in the office action in paper number 19.

11. Claims 10-12, 14-15 and 18-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Baillely (GB 2,337,054) for the reasons set forth in the office action in paper number 19.

***Response to Applicants' Arguments***

12. Applicant's arguments filed on February 3, 2003 have been fully considered but they are not persuasive.

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With respect to the obviousness rejection based upon Block, Applicants argue that previous calculations of a range for  $c$  of 7.5 to 30 were in error and allege that the correct range for  $c$  is 0.75 to 3.

The Examiner respectfully disagrees with the above argument because the previous calculations are correct. Solving for  $c$  (minimum),  $c = 7.5(100 \mu\text{m})/(7.5 + 92.5) = 7.5$ . Solving for  $c$  (maximum),  $c = 7.5(400 \mu\text{m})/(7.5 + 92.5) = 30$ . Hence, a *prima facie* case of obviousness exists because the claimed ranges "overlap or lie inside ranges disclosed by the prior art", see *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976; *In re Woodruff*, 919 F.2d 1575, 16USPQ2d 1934 (Fed. Cir. 1990). See MPEP 2131.03 and MPEP 2144.05I. In addition, Applicants have not provided any showing of unexpected properties when  $c$  is of the claimed range when compared with those outside the claimed range but within the range disclosed by the prior art.

With respect to the obviousness rejection based upon Baillely, Applicants argue that Baillely yields a range of 0.015 to 200, and more narrowly 0.11 to 50, for  $c$ . Applicants also argue that it is not seen how this disclosure somehow evinces an understanding that size and weight variables of applicants' process are critical.

The Examiner respectfully disagrees with the above argument because it is very clear that the claimed range overlap those disclosed by Baillely. As already cited above, a *prima facie* case of obviousness exists because the claimed ranges "overlap or lie inside ranges disclosed by the prior art". Again, Applicants have not provided any showing of unexpected properties when  $c$  is

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of the claimed range when compared with those outside the claimed range but within the range disclosed by the prior art.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is (703) 305-3773. The examiner can normally be reached on Mondays-Fridays from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for this Technology Center is:

(703) 872-9311 - for Official After Final faxes

(703) 872-9310- for all other Official faxes.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-0661.

April 4, 2003

*Lorna M. Douyon*  
Lorna M. Douyon  
Primary Examiner  
Art Unit 1751